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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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LIN, KENNY S

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/067,961	SUTHERLAND ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kenny Lin	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-20 are presented for examination.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/22/2006 has been entered.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a. The following terms lack proper antecedence basis:
    - i. The inconsistent use of “local computer servers”, “local server computers”, “local server” and “local computer server”, “local server” through out claims 1-11 render the claims unclear and cause the terms to lack antecedence basis.

### ***Claim Rejections - 35 USC § 102***

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3-7, 12 and 20 rejected under 35 U.S.C. 102(e) as being anticipated by Hoekstra et al (Hoekstra), US 6,304,277.

7. Hoekstra was cited in the previous office action.

8. As per claim 1, Hoekstra taught the invention as claimed including a system for storing digital images and providing access thereto on a photo sharing website, said system comprising

- a. a series of local computer servers storing high quality format digital images thereon (col.4, lines 9-17: *any number of a variety of image origination sites*) with each local computer server including a proxy arrangement for producing reduced quality format proxies of any of said stored high quality format digital images (col.4, lines 18-23: *reducing the pixel count of the high resolution digital image file at the image origination site to create a low resolution proxy file of the high resolution digital image file*);
- b. a transmission arrangement for transmitting said proxies to said photo sharing website to permit a user remote access to said proxies by accessing said website

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(col.5, lines 9-11, 19-28: *transmitting the compressed proxy file to an image correction site*);

- c. a series of tools to allow the user to make modifications to the proxies and produce an instruction set in accordance with said modifications (col.5, lines 43-54: *performing any of a variety of modifications on the restored low resolution proxy file...include, but not limited to, exposure correction, neutralizing color casts, optimization of reproduction range, image silhouetting, color alternation, retouching and color space conversion (e.g. series of tools)*); and
- d. means for sending said instruction set to the local computer server having the original high quality format digital images used to produce said proxies (col.6, lines 55-56: *saving the settings or modification in a script file*. col.6, lines 6-8: *transmitting the script file form the image correction site back to the image origination site*. col.6, lines 18-26, 31-38: *By applying the script file to the original high resolution digital image file, the same modifications that were specifically performed by the image correction specialist at the image correction site will be automatically performed at the image origination site to produce a corrected high resolution digital image file of professional quality*).

9. As per claim 12, Hoekstra taught the invention as claimed including a photo-sharing web server, comprising:

- a. Means for receiving a reduced quality proxy copy of a digital image from a local server that stores the digital image in a high quality image format, and for making

said proxy copy available a user over the internet (col.4, lines 9-23: *reducing the pixel count of the high resolution digital image file at the image origination site to create a low resolution proxy file of the high resolution digital image file.* col.5, lines 9-11, 19-28: *transmitting the compressed proxy file to an image correction site...file may be transmitted via internet*);

- b. Modification tools allowing the user to make modifications to said proxy copy (col.5, lines 43-54: *performing any of a variety of modifications on the restored low resolution proxy file...include, but not limited to, exposure correction, neutralizing color casts, optimization of reproduction range, image silhouetting, color alternation, retouching and color space conversion (e.g. tools)*),
- c. Means for recording modification instructions, in accordance with the modifications made to said proxy copy, for applying to the digital image stored in the high quality image format (col.6, lines 55-56: *saving the settings or modification in a script file.* col.6, lines 18-26, 31-38); and
- d. Means for sending said modification instructions to any of a series of local servers to retrieve the digital image stored in the high quality image format and to produce a modified high quality image in accordance with the modification instructions (col.6, lines 6-8: *transmitting the script file form the image correction site back to the image origination site.* col.6, lines 18-26, 31-38: *By applying the script file to the original high resolution digital image file, the same modifications that were specifically performed by the image correction specialist at the image*

*correction site will be automatically performed at the image origination site to produce a corrected high resolution digital image file of professional quality).*

10. As per claim 3, Hoekstra taught the invention as claimed in claim 1. Hoekstra further taught that each of said local server computers includes means for retrieving a stored high quality format digital image associated with an instruction set received with respect to a particular proxy and means for modifying the retrieved high quality format digital image in accordance with the instruction set and printing the modified high quality format digital image (col.1, lines 24-38).

11. As per claim 4, Hoekstra taught the invention as claimed in claim 1. Hoekstra further taught that said series of tools includes tools for cropping, image enhancement, compositing and editing (col.5, lines 43-54: *include, but not limited to*).

12. As per claim 5, Hoekstra taught the invention as claimed in claim 1. Hoekstra further taught that said local servers cooperate and accommodate transmission of said high quality format digital images there between when a local server receives an instruction set for high quality format digital image stored on a different local server (col.1, lines 24-38).

13. As per claim 6, Hoekstra taught the invention as claimed in claim 3. Hoekstra further taught that said local servers include means for recording the original or modified high quality format digital images to a removable storage media in accordance with user instructions (col.4, lines 12-17: photo labs having CD image generation facilities. Col.11, lines 1-8).

14. As per claim 7, Hoekstra taught the invention as claimed in claim 6. Hoekstra further taught that said removable storage media is a removable disk storage media (col.4, lines 12-17, col.11, lines 1-8).

15. As per claim 20, Hoekstra taught the invention as claimed in claim 1. Hoekstra further taught that said original high quality format digital images include digital images stored by a third party photo library and accessed as proxies from the photo sharing website (col.4, lines 12-17).

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 2, 8-9, 11, 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoekstra et al (Hoekstra), US 6,304,277, in view of Jackson et al (hereinafter Jackson), US 6,760,128.

18. Jackson was cited in the previous office action.



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19. As per claim 2, Hoekstra taught the invention substantially as claimed in claim 1.

Hoekstra did not specifically teach that the high quality format digital images are film scans.

Jackson taught that said high quality format digital images can be film scans (col.1, lines 28-32).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hoekstra and Jackson because Jackson's teaching of digital images uploading including scanned photographic film enables Hoekstra's method to store, process and modify digital images including scanned images and film.

20. As per claim 8, Hoekstra taught the invention substantially as claimed in claim 1.

Hoekstra did not specifically teach that said photo sharing website includes means to create a sequence of proxies and provide an instruction set therefor to said local server to form a sequence of high quality format digital images in accordance with said instruction set. Jackson taught the website includes means to create a sequence of proxies and provide an instruction set therefor to said local server to form a sequence of high quality format digital images in accordance with said instruction set (col.6, lines 59-67, col.7, lines 1-67, col.8, lines 1-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hoekstra and Jackson because Jackson's teaching of applying instructions to a set of proxies enables Hoekstra's system to process multiple proxies for production into albums.

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21. As per claim 9, Hoekstra and Jackson taught the invention substantially as claimed in claim 8. Hoekstra further taught that said sequence of high quality format digital images are recorded to a removable storage media (col.4, lines 12-17, col.11, lines 1-8).

22. As per claim 11, Hoekstra taught the invention substantially as claimed in claim 1. Hoekstra did not specifically teach that said local server computers accommodate storage of high quality format digital images for a first specified period of time and accommodate storage of specified high quality format digital images for a second specified period of time which is greater than said first specified period of time. Jackson taught that the records uploaded are temporarily or permanently stored (col.1, lines 20-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hoekstra and Jackson because Jackson's teaching of record storing retention enables Hoekstra's system to manage the length of time for storing of the records.

23. As per claim 13, Hoekstra taught the invention substantially as claimed including a method of storing, accessing, modifying and printing digital photographic records comprising:

- a. storing a digital record in a high quality image format on a local file server (col.4, lines 9-17: *any number of a variety of image origination sites*),
- b. producing, at the local file server, a substantially lower quality copy of said digital record and transmitting the copy to a website for access by a user (col.4, lines 18-23: *reducing the pixel count of the high resolution digital image file at the image origination site to create a low resolution proxy file of the high resolution digital*

*image file. col.5, lines 9-11, 19-28: transmitting the compressed proxy file to an image correction site...file may be transmitted via internet),*

- c. recording user-specified modification instructions (col.6, lines 55-56: *saving the settings or modification in a script file*), received from modification tools on the website interacting with the copy, with respect to a modified image that the user wants reproduced on a charge basis (col.5, lines 43-54: *performing any of a variety of modifications on the restored low resolution proxy file...include, but not limited to, exposure correction, neutralizing color casts, optimization of reproduction range, image silhouetting, color alternation, retouching and color space conversion (e.g. tools)),*
- d. producing at said retail outlet a high quality modified image using said retrieved high quality record and said modification instructions (col.6, lines 18-26, 31-38: *By applying the script file to the original high resolution digital image file, the same modifications that were specifically performed by the image correction specialist at the image correction site will be automatically performed at the image origination site to produce a corrected high resolution digital image file of professional quality).*

24. Hoekstra further taught to send the modification instruction at an intermediate site different from the image origination site (col.12, lines 25-27) and to retrieve image records (col.12, lines 20-24). Hoekstra did not specifically teach the intermediate site to be a retail outlet and retrieve the high quality record associated with said modification instructions at the retail

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outlet to produce high quality modified image. However, by providing the original image with modification instructions, it would have been obvious to process image modification at a different site. Jackson taught to use a production retailer to produce the customized image and products using the high resolution image record uploaded and user specified image modification instruction stored (col.11, lines 12-15) where the users are authorized users (col.1, lines 50-52, col.5, lines 27-40). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hoekstra and Jackson because Jackson's teaching of producing products using uploaded image and user modification instruction enables Hoekstra's method to print, produce digital images in customized albums, frames or other products (col.11, lines 12-15, 31-41).

25. As per claim 14, Hoekstra and Jackson taught the invention substantially as claimed in claim 13. Hoekstra further taught that said lower quality record is transmitted over the internet to a web server (col.5, lines 9-11, 19-28: *transmitting the compressed proxy file to an image correction site...file may be transmitted via internet*).

26. As per claim 15, Hoekstra and Jackson taught the invention substantially as claimed in claim 13. Hoekstra further taught that said local file sever cooperates with other local file servers and transfers high quality records to a local server associated with the retail outlet which has received instructions to produce the high quality modified image (col.1, lines 24-38).

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27. As per claim 16, Hoekstra and Jackson taught the invention substantially as claimed in claim 13. Jackson further taught that the records on the local file server are maintained only for a limited time unless instructions for long term storage are received (temporarily or permanently stored, col.1, lines 20-27).

28. As per claim 17, Hoekstra and Jackson taught the invention substantially as claimed in claim 13. Jackson further taught that said step of producing said high quality modified image prints said image (col.11, lines 12-15, 31-41).

29. As per claim 18, Hoekstra and Jackson taught the invention substantially as claimed in claim 13. Hoekstra further taught that said step of producing said high quality modified image stores said high quality modified image on a compact disk (col.4, lines 12-17: photo labs having CD image generation facilities. Col.11, lines 1-8).

30. As per claim 19, Hoekstra and Jackson taught the invention substantially as claimed in claim 13. Hoekstra further taught that said step of producing said high quality modified image stores said high quality modified image on a storage medium specified by the user (col.4, lines 12-17, col.11, lines 1-8).

31. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoekstra and Jackson as applied to claim 8 above, and further in view of Paul et al (hereinafter Paul), US 2001/0032151.

32. Paul was cited in the previous office action.

33. As per claim 10, Hoekstra and Jackson taught the invention substantially as claimed in claim 8. Hoekstra and Jackson did not specifically teach that said sequence of high quality format digital images are made available as an internet slide presentation. Paul taught to create internet slide shows using uploaded scans (pp. 0003, 0016). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hoekstra, Jackson and Paul because Paul's teaching of creating internet presentation enables Hoekstra and Jackson's system to create slide shows to share pictures using pictures and audio files uploaded.

### ***Response to Arguments***

34. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Matsuo, US 6,023,269.

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36. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl  
May 4, 2006

